

### Remarks

#### **35 U.S.C. §101 rejections**

In the March 6, 2009 Office Action claim 44, claim 45, claim 46, claim 47, claim 48, claim 49, claim 50, claim 51, claim 145, claim 146, claim 147, claim 148, claim 149, claim 159, claim 160, claim 161, claim 162 and claim 163 are rejected under 35 U.S.C. §101 as representing non statutory subject matter. The Assignee notes that the claim rejections are arbitrary and capricious, based on an incorrect conclusory statement and that they are moot because claim amendments are believed to have obviated these rejections.

#### **35 U.S.C. §102 rejections**

In the March 6, 2009 Office Action claim 34, claim 35, claim 36, claim 37, claim 38, claim 39, claim 42, claim 43, claim 44, claim 45, claim 46, claim 47, claim 50, claim 51, claim 52, claim 135, claim 136, claim 137, claim 138, claim 141, claim 142, claim 143, claim 145 and claim 149 are rejected under 35 U.S.C. §102(e) as being anticipated by Davis. The Assignee traverses the rejections for anticipation in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a *prima facie* case of anticipation. In particular, the March 6, 2009 Office Action fails to establish a *prima facie* case of anticipation for the rejected claims by: citing a document that does not explicitly or inherently describe one or more limitation for every claim, citing a document that does not have the same level of detail included in the rejected claims, by citing a document that does not arrange the limitations in the same way they are arranged in the rejected claims and by citing a document that describes an invention that would require substantial experimentation to match the functionality of the claimed invention. As summarized in previously filed declarations, the cited document provides substantial evidence of the novelty, non-obviousness and newness of the claimed invention. Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

#### **35 U.S.C. §103 rejections**

In the March 6, 2009 Office Action claim 40, claim 41, claim 48, claim 49, claim 139, claim 140, claim 144, claim 146, claim 147, claim 150, claim 151, claim 152, claim 154, claim 155, claim 156, claim 157, claim 158, claim 160, claim 161, claim 162, claim 163, claim 164, claim 165, claim 166 and claim 167 are rejected under 35 U.S.C. §103(a) as being obvious given Davis alone or in combination with Srivastava. The Examiner has cited Davis and Srivastava as references. The Assignee traverses the rejections for obviousness in a number of ways. First,

by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a *prima facie* case of obviousness. In particular, the March 6, 2009 Office Action fails to establish a *prima facie* case of obviousness by: citing documents that teach away from the claimed invention, citing documents that fail to teach one or more limitation for every claim, failing to explain the cited combination as required by *KSR v Teleflex*, citing documents that require a change in principle of operation of the disclosed inventions and citing a document and/or a document combination that would destroy the ability of one or more of the cited inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

In the March 6, 2009 Office Action claim 40, claim 41, claim 48, claim 49, claim 139, claim 140, claim 144, claim 146, claim 147, claim 150, claim 151, claim 152, claim 154, claim 155, claim 156, claim 157, claim 158, claim 160, claim 161, claim 162, claim 163, claim 164, claim 165, claim 166 and claim 167 are rejected under 35 U.S.C. §103(a) as being obvious given Davis alone or in combination with Srivastava. The Examiner has cited Davis and Srivastava as references. The Assignee traverses the rejections for obviousness in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a *prima facie* case of obviousness. In particular, the March 6, 2009 Office Action fails to establish a *prima facie* case of obviousness by: citing documents that teach away from the claimed invention, citing documents that fail to teach one or more limitation for every claim, failing to explain the combination as required by *KSR v Teleflex*, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

#### **35 U.S.C. §112 first paragraph rejections**

In the March 6, 2009 Office Action claim 34, claim 44, claim 62, claim 135, claim 136, claim 141, claim 145, claim 150, claim 155, claim 159 and claim 164 are rejected under 35 U.S.C. §112 first paragraph for allegedly failing to enable the claimed invention. The Assignee notes that the claim rejections are non-statutory and that the claim rejections are arbitrary and capricious

because the U.S.P.T.O. has issued a notice of allowance for claims containing the same language that were supported by the very similar specification language in application 10/025,794 (see Appendix of this paper for the allowed claim). Furthermore, the claim rejections are moot because claim amendments have obviated these rejections.

#### **35 U.S.C. §112 second paragraph rejections**

In the March 6, 2009 Office Action claim 34, claim 35, claim 36, claim 37, claim 38, claim 39, claim 40, claim 41, claim 42, claim 43, claim 44, claim 45, claim 46, claim 47, claim 48, claim 49, claim 50, claim 51, claim 62, claim 63, claim 64, claim 68, claim 69, claim 70, claim 90, claim 91, claim 134, claim 135, claim 136, claim 137, claim 138, claim 139, claim 140, claim 141, claim 142, claim 143, claim 144, claim 145, claim 146, claim 147, claim 148, claim 149, claim 150, claim 151, claim 152, claim 153, claim 154, claim 155, claim 156, claim 157, claim 158, claim 159, claim 160, claim 161, claim 162, claim 163, claim 164, claim 165, claim 166 and claim 167 are rejected under 35 U.S.C. §112 second paragraph for allegedly being indefinite. The Assignee notes that the claim rejections are non-statutory, arbitrary and capricious and based on at least one incorrect conclusory statement. Furthermore, these claim rejections are moot because claim amendments have obviated these rejections.

#### **Copending applications**

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see Armour & Co. v. Swift & Co., 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability. Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty

appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 11/262,146 was SEAL. Among other things SEAL teaches the use of a "semantic similarity measure" for identifying relevant information. As detailed in prior communications, this teaches away from the claimed invention that relies on a mission oriented context model. Of note is the fact that SEAL was not cited during the prosecution of U.S. Patent 7,644,047 which relies on semantic similarity measures for identifying relevant information. In a similar manner, the primary reference used to support the rejection of the claims in co-pending application 11/262,146 is Cheverst (aka GUIDE). A comparison on the key features of Cheverst to the features of the invention claimed in co-pending application 11/262,146 and the features of the invention claimed in U.S. Patent 7,474,960 shows that Cheverst appears to be a much closer match to the issued patent than it is to the rejected claims in the instant application.

Feature	Cheverst/GUIDE	7,474,960	11/262,146
Primary device	Mobile device	Vehicle with computing device	Personal computer
Primary application	Identify the best route for touring a city for a given location, weather and interests, has a map option	Identify the best route for a given context in a context map	Develop a context model and use it to identify actions that optimize an enterprise performance
Context information	Location, user interests, weather	Location, points of interest, geography	Physical (location, amount), social environment, tactical, instant, organization, mission
Context model created?	No	No	Yes
Data sources	Wireless network, Internet	Wireless networks, Internet, vehicle orientation processor	Enterprise applications, Internet
SW architecture	Client server	Client server	Layered, client server

This practice appears to have been utilized in the instant application as a number of issued patents (i.e. Davis, 6,732,095) are much closer to the references cited during the prosecution of the instant application than they are to the claimed invention.

- 2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application. This practice appears to have been relied upon during the prosecution of the instant application as it is unlikely that the primary reference, Davis, would have issued if Ranger and Bowman-Amuah been properly considered during prosecution.
- 3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter. As detailed in prior communications, this clearly applies to the instant application.
- 4) the apparently improper use of Official Notice. As noted above, this practice has been relied upon to reject the claims in the instant application.
5. the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled. As noted above, this practice has been relied upon to reject the claims in the instant application.
6. the need to traverse rejections made for informalities.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of this instant application.

Copies of cited U.S. patent application(s) (specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.

Copies of the cited U.S. Patent Application(s) (specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.

The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such

application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

#### **Request for Correction**

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent application bears no resemblance to the patent application examination standards dictated by statute and precedent. Prompt correction is requested.

#### **Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended to put the claims in final form for allowance and issue.

#### **Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matter covered by the original claims before their cancellation or modification.

#### **Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is requested.

Respectfully submitted,  
Asset Trust, Inc.  
/B.J. Bennett/  
B.J. Bennett, President  
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